

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:) Confirmation No.: 9416
Shunpei YAMAZAKI et al.) Examiner: Muhammad T. Karimy
Serial No. 10/815,654) Group Art Unit: 2894
Filed: April 2, 2004)
For: SEMICONDUCTOR DEVICE HAVING)
PAIR OF FLEXIBLE SUBSTRATES)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The present *Request* is filed pursuant to the provisions of the Pre-Appeal Brief Conference Pilot Program (1296 Off. Gaz. Pat. Office 67 (July 12, 2005); extended January 10, 2006).

The Official Action mailed June 29, 2010, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Also, filed concurrently herewith is a *Notice of Appeal*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. The Official Action includes improper rejections, errors in fact and omissions of essential elements required to establish a *prima facie* case of anticipation or obviousness.

Paragraph 3 of the Official Action continues to reject claims 48 and 61 as anticipated by U.S. Patent No. 5,085,973 to Shimizu. Paragraph 4 of the Official Action continues to reject claims 52, 56, 62, 63, 66-68, 70 and 71 as anticipated by Shimizu, or in the alternative, as obvious based on the combination of Shimizu and U.S. Patent No.

5,574,292 to Takahashi. Paragraph 6 of the Official Action continues to reject claim 69 as obvious based on the combination of Shimizu, Takahashi and U.S. Patent No. 5,427,961 to Takenouchi. The Applicant respectfully traverses the rejection because the Official Action has not established anticipation or obviousness rejections.

Please incorporate by reference the citations of caselaw at page 2 of the *Response* filed March 15, 2010.

The prior art, either alone or in combination, does not teach, either explicitly or inherently, or suggest all the features of the independent claims. Independent claims 48, 52 and 56 recite a pair of flexible insulating substrates opposing to each other and a resinous layer formed over one of the pair of the flexible insulating substrates. For the reasons provided below, Shimizu, Takahashi and Takenouchi do not teach, either explicitly or inherently, or suggest the above-referenced features of the present invention.

Please incorporate by reference the detailed arguments set forth by the Applicant at pages 2-5 of the *Response* filed March 15, 2010.

The Official Action appears to rely on one element of Shimizu as corresponding to two distinct and separately claimed elements in the present application. It is not a reasonable interpretation of Shimizu that a transparent substrate can correspond to two distinct elements, namely a resinous layer, and one of a pair of flexible insulating substrates. Further, it is noted that the present claims clearly recite that the resinous layer is formed over one of the pair of the flexible insulating substrates; that is, two distinct and separate elements are recited in the claims, which should be distinguished over the transparent substrate 1 in the prior art.

The Official Action asserts that an "upper surface portion of substrate 1" is "formed over" substrate 1 (page 3, Paper No. 20100622). However, an upper surface portion of substrate 1 is, by definition, part of substrate 1; hence, an upper surface portion cannot be reasonably said to be formed thereover.

The final Official Action newly asserts that "upper portion of the flexible substrate, as shown in Shimizu's Fig. 1 above, is interpreted as 'a resinous layer'" (page 9, Id.).

The Applicant respectfully submits that the Examiner's interpretation is wholly unsupported by the prior art of record and would not have been obvious to one of ordinary skill in the art at the time of the present invention. Shimizu merely teaches a transparent substrate 1. Shimizu does not teach, either explicitly or inherently, or suggest replacing transparent substrate 1 with two layers, one being a transparent substrate, the other being a resinous layer formed over the transparent substrate.

Original Figure 1 of Shimizu is reproduced below at left. The altered version of Figure 1 of Shimizu asserted by the Official Action is reproduced below at right (please note the addition of a horizontal dashed line, an arrow and the text "resinous layer over substrate").

FIG. 1

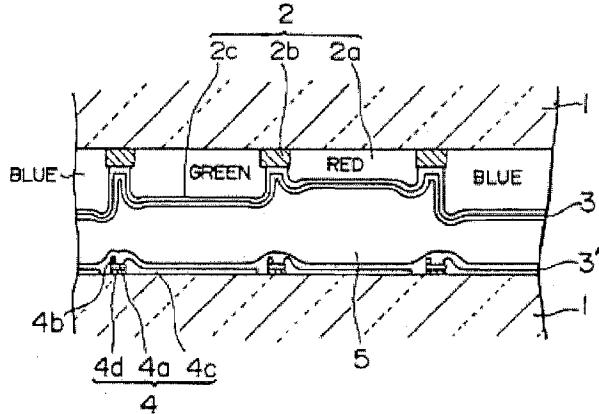
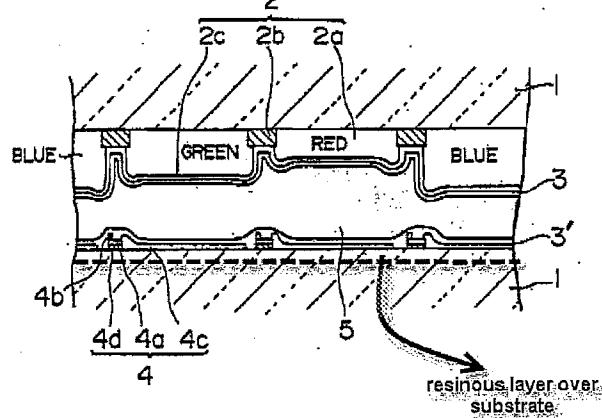


FIG. 1



Regarding this matter, the final Official Action newly asserts that "[t]he line drawn and the label added by the examiner has been included only to communicate properly examiner's application of prior art on the claims" (*Id.*). As noted in detail on the record, the prior art does not instruct one of ordinary skill in the art at the time of the present invention to interpret the reference in the manner indicated by the Examiner, *i.e.* to add a horizontal dashed line to the substrate 1 presumably indicating the formation of two layers, an arrow and the text "resinous layer over substrate." The annotation to Figure 1 of Shimizu may represent an opinion of the Examiner; however, the annotation does not represent a reasonable demonstration of the teachings of the prior art of record.

The final Official Action newly asserts that “examiner maintains that the claims limitations remain broad and the prior arts, as applied above, meet the structural limitations of the claims” (*Id.*). The Applicant respectfully disagrees and traverses the assertions in the Official Action. The Official Action, in fact, fails to set forth a *prima facie* case of anticipation or obviousness with respect to the above-referenced structural features of the present independent claims. The Examiner’s characterization of the claims as “broad” does not relieve the Examiner from setting forth an element-by-element analysis of the claims in a manner consistent with a reasonable interpretation of the teachings of the prior art. There is no teaching or suggestion in Shimizu of a resinous layer formed over a flexible insulating substrate.

The final Official Action newly asserts that “[l]ower portions of reference numeral 1 meets the feature ‘flexible insulating substrate’ and upper portion of the reference numeral 1, as shown in Fig. 1 above, meets the feature ‘resinous layer’” (*Id.*). The Applicant respectfully disagrees and traverses the assertions in the Official Action. Again, the Examiner’s statements are wholly unsupported by the prior art of record. Also, for example, the Official Action does not appear to address the fact that the claims recite “formed over.”

The final Official Action newly asserts that “Shimizu expressly teaches in column 3, lines 40-42, wherein reference numeral 1 of Fig. 1 comprises resinous insulating material” (*Id.*). Shimizu may teach a transparent substrate made of glass or plastic such as acrylic resin, but Shimizu does not teach, either explicitly or inherently, or suggest replacing transparent substrate 1 with two layers, one being a transparent substrate, the other being a resinous layer formed over the transparent substrate.

Takahashi and Takenouchi do not cure the deficiencies in Shimizu.

Therefore, the Applicant respectfully submits that Shimizu, Takahashi and Takenouchi, either alone or in combination, do not teach, either explicitly or inherently, or suggest a pair of flexible insulating substrates opposing to each other and a resinous layer formed over one of the pair of the flexible insulating substrates. Since Shimizu, Takahashi and Takenouchi do not teach, either explicitly or inherently, or suggest the

above-referenced features of the present invention, a *prima facie* case of anticipation or obviousness cannot be maintained.

Therefore, reconsideration and withdrawal of the rejections under 35 U.S.C. §§ 102 and 103 are in order and respectfully requested. Since the Official Action has not presented a *prima facie* rejection, at the very least, the Examiner's arguments are not suitable for appellate review. The Applicant respectfully requests that the present application be allowed on the existing claims pursuant to the provisions of the Pre-Appeal Brief Conference Pilot Program (1296 Off. Gaz. Pat. Office 67 (July 12, 2005); extended January 10, 2006).

Respectfully submitted,


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